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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 07027356

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on May 29, 2007

Signature: Rebecca M. Rodriguez

Typed or printed name: Rebecca M. Rodriguez

Application Number	Filed
10/713,863	11-14-2003

First Named Inventor: Magdalena Wolska

Art Unit	Examiner
2176	Singh, Rachna

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____.
- [X] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: 26,791

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Date: May 29, 2007

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [x] *Total of 2 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Magdalena Wolska, et al.	ATTORNEY DOCKET:	07027356
SERIAL NO.:	10/713,863	GROUP ART UNIT:	2176
FILED:	November 14, 2003	EXAMINER:	Singh, Rachna
TITLE:	AUTOMATED EVALUATION OF OVERLY REPETITIVE WORD USE IN AN ESSAY		
DATE:	May 29, 2007	CUSTOMER NO.:	26565

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PRE-APPEAL BRIEF REQUEST FOR REVIEW IN RESPONSE TO FINAL OFFICE ACTION DATED NOVEMBER 29, 2006

This Pre-Appeal Brief Request for Review is made in response to the final Office Action dated November 29, 2006. Further examination of the application is respectfully requested. Response to this action is timely filed on or before May 29, 2007. Therefore, a fee for a three-month extension of time is believed payable in connection with the present communication. Applicants hereby petition for a three-month extension of time under 37 C.F.R. 1.136(a) and authorize payment in the amount of $1020.00 pursuant to 37 C.F.R. 1.17(a)(3) to be charged to Deposit Account No. 13-0019. If any additional fees are due in connection with this paper, please charge such fees to Deposit Account No. 13-0019. Applicants respectfully request reconsideration and allowance of the pending claims.

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REMARKS/ARGUMENTS

I. THE REJECTION UNDER 35 U.S.C. 103(a) SHOULD BE WITHDRAWN

Applicants respectfully submit that, and as is pointed out below, clear errors exist in the final Office Action dated November 29, 2006 in the above referenced application. No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the references, when combined, must teach or suggest all the claim limitations. Second, there must an apparent reason why a person of ordinary skill would have combined the prior art elements in the manner claimed. Third, there must be a reasonable expectation of success. Memorandum from Margaret A. Focarino to USPTO Technology Center Directors dated May 3, 2007 (hereafter "PTO Staff Memo"); M.P.E.P. § 2143.

The burden of establishing a *prima facie* case of obviousness lies with the PTO. In determining obviousness, one must focus on the invention as a whole. *Symbol Technologies Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1577-78, 19 U.S.P.Q. 2d 1241 (Fed. Cir. 1991). The primary inquiry is: "[w]hether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success ... Both the suggestion and the expectation of success must be found in the prior art, not the applicant's disclosure." *In re Dow Chemical*, 837 F.2d 469, 473, 5 U.S.P.Q. 2d 1531 (Fed. Cir. 1988).

As will be discussed in detail below, Applicants submit that no *prima facie* case of obviousness has been established because the references do not disclose each and every element of the claimed invention, and because one of skill in the art at the time of the invention would not have combined these references.

A. Each and every claim limitation not disclosed

As is described in pages 8 – 9 of the Office Action response dated September 14, 2006, each and every claim limitation is not disclosed in U.S. Patent No. 6,356,864 (Foltz). Foltz discloses a methodology for analyzing and evaluating a sample text, such as an essay. Foltz also teaches assigning a grade to a sample text based on the degree of similarity between the sample text and the

standard reference text. Foltz does not teach or suggest a method for identifying at least one writing style error. Moreover, Foltz does not teach or suggest a method for displaying an indication of an identified writing style error. On page 5 of the Office Action, the Examiner cites U.S. Publication No. 2004/0093567 (Schabes) for disclosing a method for displaying an indication of an identified writing style error. Schabes discloses a methodology for correcting both the spelling and grammar of words using finite state machines. Schabes does not teach or suggest a method for identifying at least one writing style error.

Claims 1 and 16, and those claims depending therefrom require, *inter alia*, the identification of at least one writing style error. Specifically, as stated on page 10 of the Office Action response, claim 1 requires identifying at least one writing style error based on a comparison between feature values of one or more text segments and a model, and displaying an indication of at least one writing style error. In addition, as stated on page 11 of the Office Action response, claim 16 requires a display for presenting the evaluated essay, wherein the evaluated essay includes an indication of at least one identified writing style error. Rather than merely assigning a grade based on similarity of words used in a sample text and a reference text as taught by Foltz, claims 1 and 16 require **indicating** at least one writing style error based on a comparison between feature values of one or more text segments and a **model**, and displaying an indication of an identified writing style error. Foltz does not teach or suggest identifying at least one writing style error. Moreover, Schabes also does not teach or suggest identifying at least one writing style error based on a model, as required by claims 1 and 16. Schabes simply discloses a spelling and grammar checking system in which a spelling suggestion module suggests corrections for misspelled words and determines a list of alternate words.

Because the prior art of record is silent as to a step of identifying at least one writing style error, each and every limitation of Applicants' claimed invention is not disclosed in the prior art of record. Therefore, no *prima facie* case of obviousness has been established.

B. One of skill in the art would not have combined the references

Further, even if each and every limitation were disclosed in Foltz in view of Schabes, which is denied, Applicants respectfully submit that one of skill in the art would not have combined these references. Thus, their combination cannot render obvious the invention claimed. As previously set forth, to establish a *prima facie* case of obviousness when combining multiple references, there must

be an "explicit" analysis of both the claimed invention and the prior art to determine "whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l*, 2007 WL 1237837, at *13; PTO Staff Memo, May 3, 2007 (any obviousness rejection must "identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed"). Moreover, there must be "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*

Applying this rule, the Office Action dated November 29, 2006 has failed to identify why a person of ordinary skill in the art at the time of the invention would have combined Foltz in view of Schabes in the manner claimed. In addition, as stated above, even if combined these references fail to teach each limitation of the claims.

Therefore, Applicants submit that no *prima facie* case of obviousness exists, and claims 1 and 16 are patentable over Foltz in view of Schabes. As such, no *prima facie* case of obviousness has been established. Furthermore, claims 2-15 and 17-25 are patentable over the references cited in the Office Action as they depend on claims 1 and 16.

Applicants respectfully request withdrawal of the instant rejection and allowance of the claims.

Respectfully submitted,

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